

No. 50.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

CONSOLIDATED PIEDMONT CABLE COMPANY,
APPELLANT,

v's.

PACIFIC CABLE RAILWAY COMPANY,
APPELLEE.

APPELLANT'S PETITION FOR A REHEARING.

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In the case of *Consolidated Piedmont Cable Company vs. Pacific Cable Railway Company*—No. 55—which was decided at the same time that this case—No. 50—was decided, we have prepared a petition for a rehearing, and in order to save the trouble of going twice over the same grounds that are discussed in that petition, we ask the Court to read that petition in connection with this one. In the belief that the Court will do so, we make this petition short, and make it apply to the details of this case instead of making it to cover the general principles which belong to both the cases. We also ask that our briefs in this case be read in connection with this petition.

We have obtained a copy of the opinion rendered by the Court in this case, and the more we read it and endeavor to make out what it says and what it means, the more nonplussed we become.

The suit is brought for an alleged infringement of one claim out of seven of patent No. 189,204, granted to William Epelheimer, for improvements in cable-car grips.

The patent has seven claims, and it is admitted that there is none of the claims infringed, unless it is the third claim.

This third claim is a combination claim, and five elements are enumerated by the claim as those constituting its combination. They are the shank E, the hinged clamping jaws *e*, the slide F, its cross-bar *f*², and bearing rollers *f*.

The defendant's grip has hinged clamping jaws, and it has a slide similar to the slide F, and it has a shank similar to the shank E, and it has the circular arms which answer to the cross piece, or cross bar *f*² of the patent. But both the Court and the parties agree that it has no friction rollers. Of course,

friction rollers are tangible devices, composed of substantial material, and if they were in the defendant's grip they would be easily discernable. They simply are not there. The question is whether there are any mechanical equivalents of them there or not.

While the claim sued upon has but five elements enumerated, there are included in the combination of those five devices other necessary elements, which are fully described in the specifications of the patent, but are not mentioned in the claim, and those are the axles f^1 . The specifications say: "The outer faces of these jaws are inclined outwardly from the hinge joint to their lower edges, as shown at e^1 , Fig. 3, and upon these faces are arranged to bear friction rollers f , which are mounted ON AXLES f^1 arranged above the jaws, and fixed in, and carried by, a cross-piece, f^2 , which is fixed on the lower end of the slide F."

While these axles are not enumerated as elements of the combination in the claim they are necessary devices in it for the purpose of holding the rollers in place and connecting the cross-piece, the rollers, and inclined faces of the swinging jaws together. We can see no reason why those axles, f^1 , do not correspond to the pins at the ends of the circular arms of the defendant's grip, which connect those circular arms with the defendant's swinging jaws. The defendant's circular arms constitute its cross-piece, and those axles are in the ends of this cross-piece in the patent in exactly the same location as are the pins in the defendant's grip. In both instances the axles and the pins are necessary, and in both cases they are used for the one purpose of connecting the ends of the cross-piece with the next devices in the grip. In the patent the next devices with which these pins or axles connect the ends of the cross-piece are the friction rollers, while in the defendant's grip the next devices with which these pins connect the ends of the cross-piece are the swinging jaws themselves. Now in making this statement we ask the Court: HAVE WE NOT MADE IT EXACTLY AS IT IS? DOES NOT THE AXLES OF THE PATENT CONNECT THE ENDS OF THE CROSS-PIECE f^2 WITH THE FRICTION ROLLERS, AND IN THE DEFENDANT'S GRIP DO NOT THE PINS CONNECT THE ENDS OF THE CROSS-PIECE DIRECTLY WITH THE SWINGING JAWS OF THE GRIP?

ARE THERE NOT THE FRICTION ROLLERS BETWEEN THE PINS OR AXLES AND THE SWINGING JAWS IN THE PATENT, AND IN THE DEFENDANT'S GRIP ARE NOT THE PINS WHICH ARE IN THE

ENDS OF THE CIRCULAR ARMS, WHICH CONSTITUTE THE ONLY CROSS-PIECE THAT THERE IS IN THE DEFENDANT'S GRIP, CONNECTED DIRECTLY WITH THE SWINGING JAWS WITHOUT THE APPLICATION OF ANY FRICTION ROLLERS OR ANY OTHER DEVICE AT ALL? IF THESE THINGS ARE SO ARE THERE NOT THE FRICTION ROLLERS, WHICH ARE CALLED FOR BY THE CLAIM OF THE PATENT, IN THE PLAINTIFF'S GRIP BETWEEN THE AXELS AND SWINGING JAWS OF THE GRIP, AND IS THERE NOT AN ENTIRE ABSENCE OF FRICTION ROLLERS, OR ANY EQUIVALENT OF THEM, BETWEEN THE PINS IN THE ENDS OF THE CROSS-PIECE AND THE SWINGING JAWS IN THE DEFENDANT'S GRIP?

Evidently there can be given but one truthful or sensible answer to each of the foregoing questions. The grips are proved, and their construction is proved, and their operation is proved. The plaintiff's grip is operated with a sliding operation along the inclined surface of the swinging jaws and there is put in friction rollers to relieve the friction of the sliding contact. The defendant's grip is constructed to operate without inclined surfaces to its jaws and with but little if any friction to overcome and it does not need and does not use any friction rollers or any equivalent device.

Now as plain as these facts are, and there cannot be a Judge upon this bench who has examined and understands the patent and the defendant's grip who does not know that these are the facts as certainly as he knows that the sun shines in the heavens, we still have to seriously contend for an application of the only known rule of law that applies to the case, which is, that so long as there are no friction rollers, nor any equivalent of them in the defendant's grip that the claim is not infringed. Now we repeat that the friction rollers of the patent are between the axles at the ends of the cross-piece that the slide F, carries up and down and the swinging arms. The pins in the defendant's grip connects those ends of the cross-piece directly with the swinging arms WITH NOTHING BETWEEN THEM. THERE BEING ABSOLUTELY NOTHING BETWEEN THESE PINS AND THE SWINGING ARMS, THERE CAN BE NO MECHANICAL EQUIVALENT OF THE ROLLERS THERE. NOTHING CANNOT BE A MECHANICAL EQUIVALENT OF FRICTION ROLLERS. At least it could not be in any Court outside of the Pacific Coast, and we propose to keep up our contests with the courts here until they will finally see that patent cases should be decided like others, upon plain principles of fact, and of law, and of common sense.

We now refer to the opinion that has been rendered in this case. We do not wish to criticise any inadvertent expressions or give any meaning to any expression other than just what the Court intended. We only desire to criticise the opinion so far as its real merits and conclusions apply to the real merits of the case.

The opinion says:

“ In the plaintiff’s machine the pressure which secures the grip of the cable is exerted through friction rollers. In the defendant’s machine through what was called in argument a bell crank. In the testimony it was assimilated by an expert witness to a toggle-joint. If it is either it is an equivalent. A bell crank is a well known mechanical device and a toggle-joint was held an equivalent to exert pressure of friction rollers by Judge Washington in *Gray et al. vs. James et al.*, 1 Pet. C. C., 399.”

Now, the astonishing part of the foregoing is that the Court overlooked the fact that the bell crank or toggle-joint of the defendant’s machine to which it refers and to which the testimony related, WAS THE SWINGING JAWS THEMSELVES, AND WERE NOT ANY DEVICES BY WHICH PRESSURE WAS APPLIED TO THOSE SWINGING JAWS. The friction rollers of the patent are for the one purpose of exerting pressure upon the swinging jaws. In the defendant’s grip the pressure is exerted directly upon the swinging jaws by the pins, which are in the same relative place, and correspond to the axles of the patent. No device intervenes between those pins and the swinging jaws, which are the bell cranks or toggle-joints of the testimony, and of the opinion of the Court.

In the case which the Court cites—*Gray vs. James*—we do not understand that the Court held that a friction roller was the equivalent of a toggle. The statement contained in the decision shows that the plaintiff operated two jaws of the nail machine by the use of a lever of the first order acting upon a toggle-joint which compressed the jaws together. The defendant used two jaws, and operated them by the use of a lever of the second order with a friction roller acting upon an inclined plane that was made on the moving jaw of the vice. It was the defendant and not the plaintiff in that case who used the friction roller and the inclined plane to close the jaws. These were held to be the equivalent of the toggle-joint of the plaintiff for closing the jaws. But BOTH THE FRICTION ROLLERS AND THE TOGGLE-JOINT WERE BETWEEN THE LEVER AND THE

JAWS THAT WERE PRESSED UPON—IN NEITHER CASE DID EITHER OF THE JAWS CONSTITUTE ANY PART OF EITHER THE TOGGLE-JOINT OR THE FRICTION ROLLER. The case, therefore, is no authority for holding that the swinging jaw of the defendant's machine is a toggle-joint that takes the place of the friction rollers. Those swinging jaws, whether they are toggle-joints or bell-cranks, are used to press against the cable, just as the swinging jaws of the patent are used to press against the cable. Now, if the Court says that the swinging jaws of the defendant's grip take the place of the friction rollers that press upon the swinging jaws, instead of being the swinging jaws themselves, where does the Court find in the defendant's grip any swinging jaws? In the patent the swinging jaws are one thing and the friction rollers are another thing, and they are both made elements of the third claim. In that claim the swinging jaws are not the rollers, nor are the rollers the swinging jaws, but they are two different, distinct mechanical elements, and unless both are in the defendant's grip there is no infringement. Now, we repeat, if the defendant's swinging jaws, or those things that we had supposed were swinging jaws before the Court said that they were the equivalents of the friction rollers, are the equivalents of the friction rollers instead of being the swinging jaws, then where are the swinging jaws or the equivalents of swinging jaws in the defendant's grip? Those jaws cannot be the mechanical equivalents of the friction rollers which press upon the swinging jaws, and at the same time be the swinging jaws that are pressed upon by the rollers, or their equivalents. May we not now expect the Court to take a reasonable matter of fact view of this case, as it does of other kinds of cases, and decide facts as they are? What can there be of advantage in decreeing impossible things to be facts, and in decreeing that the plainest of facts have no existence? How can the Court hope to do justice between litigants by making such decrees? While its decrees must be obeyed, because of the judicial power of the Court that creates them, can they be otherwise respected? Now, we repeat that the Court has not found and it cannot find the friction rollers or any equivalent of them in the defendant's grip. The pins in the ends of the cross piece connect directly with the swinging jaws, without the interposition of any device of any nature or kind between them. The defendant's construction does not have any sliding surfaces that afford any place in which to use any friction rollers. The patented grip on

the other hand does have those sliding surfaces, and it does have a place where it can put friction rollers, and that place is between the axles at the ends of the cross-piece and the swinging jaws. The patent puts those friction rollers in that one place and it puts them nowhere else, and the claim covers them in just that combination, and it does not cover them in any other place, or in any other or different combination. In both grips the swinging jaws are swinging jaws, and in neither case are they anything else. In neither case are they mechanical equivalents of the friction rollers, or anything other than just swinging jaws.

The case cited by the Court—*Gray vs. James*—is an authority now only in cases in which the patent covers an entire machine. The old law under which the patent was issued in that case was not strict as the present law is in requiring that the inventor must particularly point out and specify what he claims as his invention. In that case the patent was construed to be for the entire machine. The machine itself was the first machine that was ever made by which a nail could be cut and headed by one movement of the jaws. It was a new kind of machine and was not a mere improvement on some other machine. There was not a claim made for a sub-combination of its devices as there is in this case, and the rule of law applicable to combination claims had no application as it has here and it was not applied. Still the case has no application to the facts of this case as we have shown for the reason that both the toggle-joint, in the one machine, and the friction roller in the other came between the lever and the jaw, and there was no decision to the effect that the jaw itself was the mechanical equivalent of something that was between the lever and the jaw as described in the patent.

The opinion of the Court rendered in this case says further on: “The axles and rollers are the cross-piece of the operating slide of the plaintiff’s machine, their counter parts in the defendant’s machine are the circular arms of its operating slide and the pins connecting them with the gripping jaws. Extend the pin described in the specifications as E⁵, which is set in one of the eye pieces of the hinge joint of the gripping jaws of the plaintiff’s machine around the roller embracing them tightly so that the jaws and rollers are one, there is revealed the defendant’s device.”

We are unable to understand what the Court means by this language. The pin *e*⁵ of the patent (which is the one

which the Court refers to as E⁵) is a pin that is used for opening the jaws and it is not used for closing them, or to assist the pressure in any way.

Now if that pin was extended around the rollers so tightly that the rollers and jaws would be practically one, the entire machine would be utterly inoperative. As made the rollers must move up and down along the inclined surface of the jaws. If those rollers were fixed to the jaws so as to become a part of the jaws "so that the jaws and rollers are one," of course they could not be moved up and down along those inclined surfaces. If the rollers and jaws were one the rollers could not be moved unless the entire jaw moved also. In order to operate the patented grip the jaws must remain stationary as to elevation while the rollers must move up and down. Suppose, however, that the rollers and jaws were made one, may we inquire of the Court what that thing would be? Would it be the rollers, or would it be the swinging jaws, or would it be something like a cross between a mule and a yoke of oxen. We can understand it well enough to see that it would not be grip for the reasons above mentioned, viz.: the rollers would be fast to the slide F, and at the same time would be solid with the jaws and as the rollers *must move along the jaws* to make a grip of the apparatus it is evident to every one outside of a Court that the apparatus would not grip. Now, as the defendant's grip is a grip, and does operate, it is equally evident that if the pin e⁵, was extended around the rollers embracing them tightly so that the jaws and rollers are one, there would not be revealed the defendant's device nor anything that would be a grip at all.

Again, what does the Court mean by saying that "the axles are rollers are the cross-piece of the operating slide of plaintiff's machine." The patent says that the cross-piece is the piece marked f^2 . This piece marked f^2 , is shown in figures 1 and 2 of the patent, although it does not have the letter f^2 attached to it in figure 2. The letters h^1 appear just above it but they represent the bend in the spring arm h and not the cross-piece. The drawings show this cross piece f^2 , to be of a considerable length, and also of considerable width. In Figure 1, its *width* is shown. It carries an axle on each end, and each axle carries two friction rollers f , making four of these friction rollers for the grip, two at each end of the cross piece f^2 . The length of the cross piece f^2 (without the letter f^2 attached), is shown in Figure 2. It is the piece in Figure

2 that is shown attached to the lower end of the slide F, and reaches across the two swinging jaws pretty high up, and has a large enlargement at each end that curves downwards, and in each of which enlargements is shown in cross-section the axle f^1 and also one of the friction rollers f . This cross-piece is mentioned in the specifications as the cross-piece f^2 , and is so fully shown in the drawings both as to its length and breadth that we are utterly unable to make out what the Court means when it says that "the axles and rollers are the cross-piece of the operating slide of the plaintiff's machines." Neither one of those axles or rollers come within a considerable distance of the operating slide F, and the cross piece f^2 , is absolutely requisite in order to make the necessary connection between those axles and rollers and the slide. Without that cross piece f^2 , there would be no connection whatever between the slide F and those axles or friction rollers f .

Now we ask the Court to grant a rehearing herein, and to decide this case according to the law and the facts of it. If the pins of the defendant's grip, which connect the cross-piece of the slide with the swinging jaws of the grip constitute an element in that grip, then the axles of the plaintiff's grip are equally an element in that grip. If those axles are counted as an element of the combination of claim three then that claim has six elements instead of five. If those axles are not counted as an element in claim three then the corresponding connecting pins in the defendant's grip ought not to be counted as an element, and then there would only be four elements of the defendant's grip that corresponds with the elements named in the said claim three. However counted, or however compared, there are always the friction rollers in the plaintiff's claim which are a part of the combination covered by that claim, and there are no friction rollers, nor any place or occasion to use friction rollers, and no device performing the duties of those friction rollers, nor any equivalents of those friction rollers in the defendant's machine. There cannot therefore be any infringement of claim three in the defendant's device. May we not hope that a decision may yet be rendered that can be read hereafter without causing staring eyes and inexpressible wonder in the reader.

It seems to us that the courts here seem to think in patent cases that if the defendant's devices produce the same effect which the patented combination produces that it is their re-

ligious duty to work out an infringement at any cost, even though every rule of law has to be violated, every existing fact distorted, or totally denied, and new and impossible facts created out of nothing, and every particle of common sense suppressed. The law is not so. The *effect* which a patented machine or combination produces *cannot be patented*. It is *only the means by which the effect is produced* that is patentable, and any other person is at liberty to produce the same effect if he can do so without using the same means that are patented. This has always been the rule of law. See

Robinson on Patents, Sec. 149, also Sec. 90 and the citations under it. Also

O'Reilly vs. Morse, 15 Howard, pages 112 to 120.

Electric Signal Co. vs. Hall Signal Co., 114 U. S., page 96.

The unbroken line of decisions from the above case of *O'Reilly vs. Morse* to the present time is to the effect that a patent does not cover the effect produced, and that any subsequent inventor is at liberty to produce the same effect if he can do so without using the means patented. Indeed it is very often the case that the effect produced by the patented means is but an effect already known, and one that is in common use and used without the application of any patented means. It was so in this case. All the ultimate effects produced by the plaintiff's grip were produced by the grip of the original Hallidie patent of 1872. Not only this but the general principle and principal devices and combinations of devices were shown in that old expired patent. In that patent as in this there was the stationary part of the gripping apparatus that was attached to the car. There was the stationary shank that passed down through the street slot into the rope chamber below. There was the movable slide, like F, of the patent that was operated from above and which by being raised or lowered closed the jaws below upon the cable, or opened them and released the cable, and there were also the jaws that were used to clasp the cable to make the car go or that were released from the cable to make the car stop. The general principle upon which the plaintiff's grip operates, as well as the principle, devices and combinations of devices by which its operations are performed, are public property. None of them were invented or discovered by the patentee. Eppelsheimer was employed by Hallidie and was shown all

these things by Mr. Hallidie. Will not the courts here at some time quit giving the mechanical principles of machines to improvers, when the evidence proves beyond a doubt that such mechanical principles were not invented or discovered by such improvers, but were appropriated by them either from the common knowledge of the public or from the patents of prior inventors. In this case the Court could have said in comparing the plaintiff's patented grip with the Hallidie grip, which is now public property in law, and with as much consistency, the same that it has said in comparing the defendant's grip with the plaintiff's, viz.: "The plaintiff's device manifestly escapes exact imitation of Hallidie's by only formal differences."

We respectfully ask that a rehearing may be granted herein.

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F. J. KIERCE,
Counsel for Appellant.

We, the undersigned, hereby certify that we are counsel for the appellant in the foregoing entitled cause, and that we have prepared the foregoing petition for a rehearing therein; we further certify that, in our opinion and judgment, the said petition is well founded in law and is proper to be filed in said cause.

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